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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,566	02/03/2005	Kazuhiro Yagishita	CU-4079 RJS	1177

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EXAMINER

GOLOBOY, JAMES C

ART UNIT	PAPER NUMBER
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1797

MAIL DATE	DELIVERY MODE
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07/24/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/523,566	Applicant(s) YAGISHITA, KAZUHIRO	
	Examiner James Goloboy	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 14 and 15 is/are rejected.
- 7) ☒ Claim(s) 12-13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's amendments and arguments filed 3/27/08 fail to overcome the rejections set forth in the office action mailed 12/27/07, except for the rejection of claims 12-13.

Claim Rejections - 35 USC § 103

2. Claims 1-2, 5-6, 8-9, 11, and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katafuchi.

The rejection of claims 1-2, 5-6, 8-9, and 11 is adequately set forth in paragraph 2 of the office action mailed 12/27/07, which is incorporated here by reference. Newly added claims 14 and 15 are rejected on the same grounds.

3. Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katafuchi in view of Curtis.

This rejection is adequately set forth in paragraph 3 of the office action mailed 12/27/07, which is incorporated here by reference.

4. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katafuchi in view of Papay.

This rejection is adequately set forth in paragraph 4 of the office action mailed 12/27/07, which is incorporated here by reference.

5. Claims 1-4, 8-9, 11, and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chambard.

The rejection of claims 1-4, 8-9, and 11 is adequately set forth in paragraph 6 of the office action mailed 12/27/07, which is incorporated here by reference. Newly added claims 14-15 are rejected on the same grounds.

Allowable Subject Matter

6. Claims 12-13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 12 recites a specific salicylate containing 2 alkyl groups, one of which has from 10 to 40 carbon atoms, and the other of which has less than 5 carbon atoms. While these salicylates are encompassed by the salicylates of Tamoto, there are thousands of possible salicylates within the scope of Tamoto, and no motivation for one of ordinary skill in the art to select from those thousands the limited number within the scope of the claim. Katafuchi and Tamoto fail to render claim 13 obvious for the same reason. Claim 13 has been amended to limit the second alkyl group to less than 5 carbon atoms, overcoming the Chambard reference which requires the alkyl groups to have at least 5 carbon atoms.

Response to Arguments

7. Applicant's arguments filed 3/27/08 have been fully considered but they are not persuasive. Applicant argues that the composition of Katafuchi must contain the

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salicylate in a concentration greater than the claimed range in order to obtain the desired TBN of Katafuchi. However, Katafuchi teaches that the composition can contain additional detergents besides the salicylate (see the examples in Table 1), which will also contribute to the TBN. Therefore, the composition of Katafuchi can contain calcium salicylate in a concentration such that the metal concentration is within the claimed range.

Applicant further argues that the references do not disclose salicylates that are substituted in the 3- and 5- positions. However, as noted in the previous office actions, the number of possible positions for the two alkyl groups is so small that it is as if the specific claimed compound was disclosed by both Katafuchi and Chambard.

Applicant also argues that Katafuchi does not meet the limitation of claim 1 regarding the sulfur content of the base oils. However, as stated in the previous office action, Katafuchi teaches that the base oil can be certain synthetic oils that do not contain sulfur.

Finally, applicant disputes the rejection of claims 6-7 over Katafuchi in view of Papay. While it is noted that paragraph 4 of the office action mailed 12/27/07 contains an obvious typographical error (the rejection makes some references to claims 2 and 4, which should be claims 6 and 7), it is clear that Papay suggests to one of ordinary skill in the art to replace the zinc-containing antiwear agents of Katafuchi with non zinc- or sulfur-containing antiwear agents, and therefore claims 6-7 are rendered obvious.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Goloboy whose telephone number is (571)272-2476. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JCG

/Glenn A Caldarola/
Acting SPE of Art Unit 1797